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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,972	08/22/2006	Blerim Rexha	449122086100	7390
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K&L Gates LLP P.O. BOX 1135 CHICAGO, IL 60690			EXAMINER STU, SARAH	
			ART UNIT 2431	PAPER NUMBER
			MAIL DATE 03/17/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/567,972

**Applicant(s)**

REXHA ET AL.

**Examiner**

Sarah Su

**Art Unit**

2431

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1,2,9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-06)  
Paper No(s)/Mail Date 2/10/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Preliminary Amendment, received on 10 February 2006, has been entered into record. In this amendment, claims 1-10 have been amended.
2. Claims 1-10 are presented for examination.

### ***Priority***

3. The claim for priority from PCT/EP04/51749 filed on 9 August 2004 is duly noted.
4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

6. Claims 1, 2, 9, and 10 are objected to because of the following informalities:

- a. In claim 1, line 13: "the information" is unclear if it relates to "first information" (claim 1, line 2) or "second information" (claim 1, line 5);
- b. In claim 2, line 12: "the first or second seller" lacks antecedent basis;
- c. In claim 9, line 4: "the certificate" lacks antecedent basis and should read --a certificate--;
- d. In claim 10, line 3: "the certificate" lacks antecedent basis and should read --a certificate--;
- e. In claim 10, line 3: "the storage medium" lacks antecedent basis and should read --a storage medium--.

Appropriate correction is required.

### ***Drawings***

7. Figure 1a should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitty et al. (US Patent 6,145,079 and Mitty hereinafter).

As to claim 1, Mitty discloses a system and method for secure electronic transaction using a trusted intermediary to perform electronic services, the system and method having:

**transmitting first information** (i.e. inner envelope) **from a user** (i.e. sender) **of a telecommunication network to a first provider** (i.e. recipient) (col. 3, lines 41-44);

**transmitting second information** (i.e. first information structure) **from the user** (i.e. sender) **to a second provider** (i.e. intermediary) (col. 2, lines 38-45), **wherein the first information is encrypted in accordance with specifications of the first provider** (col. 2, lines 31-34),

**the second information includes a single- or multi-part component which is encrypted in accordance with specifications of the second provider** (col. 2, lines 38-41), and

**the information is sent in a common information unit** (first package) (col. 2, lines 41-44).

As to claim 2, Mitty discloses:

**transmitting first information** (i.e. inner envelope) **from a user** (i.e. sender) **of a telecommunication network to a first provider** (i.e. recipient) (col. 3, lines 41-44);

**transmitting second information** (i.e. first information structure) **from the user** (i.e. sender) **to a second provider** (i.e. intermediary) (col. 2, lines 38-45), **wherein the first information is encrypted in accordance with specifications of the first provider** (col. 2, lines 31-34),

**the second information includes a single- or multi-part component which is encrypted in accordance with specifications of the second provider** (col. 2, lines 38-41) **and,**

**the second information** (i.e. first information structure, waybill) **is stored by the first or second seller in a data memory which can be accessed by the first and second seller** (col. 15, lines 22-25, 34-36).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitty as applied to claim 1 above, and in view of Elgamal (US Patent 5,671,279).

As to claim 3, Mitty fails to specifically disclose:

**wherein a private extension of a certificate conforming to the X.509 standard is used for storing the second information.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Mitty, as taught by Elgamal.

Elgamal discloses a system and method for electronic commerce using a secure courier system, the system and method having:

**wherein a private extension of a certificate conforming to the X.509 standard is used for storing the second information (col. 37, lines 22-28).**

Given the teaching of Elgamal, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying

the teachings of Mitty with the teachings of Elgamal by using a certificate extension to store information. Elgamal recites motivation by disclosing that using version 3 of the X.509 certificate format allows for several optional attributes that can identify the certificate capabilities and properties and increase flexibility (col. 37, lines 26-31). It is obvious that the teachings of Elgamal would have improved the teachings of Mitty but using certificate extensions to store information in order to further identify the certificate capabilities and allow different subsystems to use the certificates.

As to claim 4, Mitty fails to specifically disclose:

**wherein the method is used for a payment transaction and the transmitted first and/or second information relates to the payment transaction.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Mitty, as taught by Elgamal.

Elgamal discloses:

**wherein the method is used for a payment transaction and the transmitted first and/or second information relates to the payment transaction (col. 3, lines 47-52).**

Given the teaching of Elgamal, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Mitty with the teachings of Elgamal by performing a payment transaction. Elgamal recites motivation by disclosing that the secure transmissions



govern the relationship between a customer, merchant, and acquirer gateway to perform credit card purchases over such networks as the Internet to simply the problem of Internet-based financial transactions (col. 3, lines 2-9). It is obvious that the teachings of Elgamal would have improved the teachings of Mitty by applying the method for a payment transaction in order to allow for credit card purchases over the Internet in a secure manner.

As to claim 5, Mitty discloses:

**wherein a unique transaction number (i.e. waybill ID) is assigned to the payment transaction by the second provider or by the user** (col. 8, lines 65-67; col. 9, lines 1-2).

As to claim 6, Mitty fails to specifically disclose:

**wherein an identity certificate extension is used.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Mitty, as taught by Elgamal.

Elgamal discloses:

**wherein an identity certificate extension is used** (col. 37, lines 22-28).

Given the teaching of Elgamal, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Mitty with the teachings of Elgamal by using an identity certificate

extension. Please refer to the motivation recited above with respect to claim 3 as to why it is obvious to apply the teachings of Elgamal to the teachings of Mitty.

As to claim 7, Mitty fails to specifically disclose:

**wherein an attribute certificate extension is used.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Mitty, as taught by Elgamal.

Elgamal discloses:

**wherein an attribute certificate extension is used** (col. 37, lines 22-28).

Given the teaching of Elgamal, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Mitty with the teachings of Elgamal by using an attribute certificate extension. Please refer to the motivation recited above with respect to claim 3 as to why it is obvious to apply the teachings of Elgamal to the teachings of Mitty.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitty in view of Elgamal as applied to claim 7 above, and further in view of Cornuejols et al. (US Patent 7,020,774 B1 and Cornuejols hereinafter).

As to claim 8, Mitty in view of Elgamal fails to specifically disclose:

**wherein an attribute certificate can be used precisely once.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Mitty in view of Elgamal, as taught by Cornuejols.

Cornuejols discloses a system and method for the transmission of data using a certificate of integrity, the system and method having:

**wherein an attribute certificate can be used precisely once** (col. 27, lines 19-21; col. 32, lines 54-60).

Given the teaching of Cornuejols, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Mitty in view of Elgamal with the teachings of Cornuejols by using a certificate only once. Cornuejols recites motivation by disclosing that invalidating a single-use means of payment following the first payment operation provides security for the means of payment (col. 3, lines 50-53). It is obvious that the teachings of Cornuejols would have improved the teachings of Mitty in view of Elgamal by using a certificate once in order to protect payment information by preventing it from being used more than once.

14. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitty as applied to claim 1 above, and in view of Nambiar et al. (US 2002/0128977 A1 and Nambiar hereinafter).

As to claim 9, Mitty fails to specifically disclose:

**wherein a suitable storage medium, smart dongle or a storage medium that can be read contactlessly, is used for storing the certificate.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Mitty, as taught by Nambiar.

Nambiar discloses a system and method for microchip-enabled online transactions, the system and method having:

**wherein a suitable storage medium, smart dongle or a storage medium that can be read contactlessly, is used for storing the certificate**  
(0045, lines 6-10).

Given the teaching of Nambiar, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Mitty with the teachings of Nambiar by storing a certificate on a smart card. Nambiar recites motivation by disclosing that storing a certificate required for a transaction on a smart card provides for authenticating remote and/or online users of transaction cards (0004, lines 13-17) by implementing a two-factor authentication requiring something you have with something known (0045, lines 1-6). It is obvious that the teachings of Nambiar would have improved the teachings of Mitty by storing a certificate on a smart card in order to provide reassurance to a merchant that the remote user of a transaction card is authorized to use the card.

As to claim 10, Mitty fails to specifically disclose:

**wherein the certificate is stored on the storage medium, protected by a password.**

Nonetheless, this feature is well known in the art and would have been an obvious modification of the teachings disclosed by Mitty, as taught by Nambiar.

Nambiar discloses:

**wherein the certificate is stored on the storage medium, protected by a password (0045, lines 14-18).**

Given the teaching of Nambiar, a person having ordinary skill in the art at the time of the invention would have readily recognized the desirability and advantages of modifying the teachings of Mitty with the teachings of Nambiar by protecting a stored certificate with a password. Please refer to the motivation recited above with respect to claim 9 as to why it is obvious to apply the teachings of Nambiar to the teachings of Mitty.

***Prior Art Made of Record***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Corella (US Patent 6,802,002 B1) discloses a system and method for providing field confidentiality in digital certificates.
- b. Geer, Jr. et al. (US Patent 6,212,634 B1) discloses a system and method for certifying authorization in computer networks.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah Su whose telephone number is (571) 270-3835. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sarah Su/  
Examiner, Art Unit 2431

/Christopher A. Revak/  
Primary Examiner, Art Unit 2431